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| 09/678,487      | 10/03/2000  | Bradley Dee Carlson  | 447                 | 6194             |

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Ms. Joan Parkinson Firth  
11428 N. Sundown Drive  
Scottsdale, AZ 85260

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| EXAMINER |
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JAMAL, ALEXANDER

| ART UNIT | PAPER NUMBER |
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| 2643     | 6            |

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,487

Applicant(s)

CARLSON ET AL.

Examiner

Alexander Jamal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Withdrawal of Claims*

1. Examiner acknowledges the withdrawal of **claim 17**.

### *Response to Arguments*

2. Applicant's arguments with respect to **claims 1-16** have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- a. **Claim 3** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim states 'wherein said microprocessor thereupon being operative, in the event said located stored prefix is valid in a plurality of area codes, for enabling selection of one of said plurality of located area codes and for then initiating dialing of said selected located area code, followed by said second plurality of digits being entered by the user'. The claim describes a process where the device receives part of a number (a prefix), then an

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association with an area code (or codes) is made (applicant's argument page 7, 3<sup>rd</sup> paragraph). Then the device allows the user to select a valid area code from a plurality of choices, and then continue dialing the rest of the 'second plurality of numbers'.

Applicant's specification discloses that the device will only enable the selection of a correct area code from a plurality of possible area codes after 7 digits (the complete 'second plurality of digits') have been dialed (Applicant's specification page 10 paragraph 1 and Fig. 4D). The specification does not enable the claimed invention.

**b. Claims 4-8** depend from claim 3. As such they are also rejected.

Examiner also notes that even if the applicant's specification supported the claim as written, the teachings of Yamartino and Eaton (as applied to claim 1 below) would still be applicable to the claims.

***Claim Rejections - 35 USC § 102***

**4.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 9-15** rejected under 35 U.S.C. 102(e) as being anticipated by Yamartino (09291213).

a. **Claim 9:** Yamartino discloses a method for auto-dialing a telephone number (comprising a prefix, suffix, and area code) after the caller has entered a standard 7-digit telephone number (without the area code) comprising:

- i. Storing telephone number area codes along with their associated 7-digit telephone numbers (comprising prefix and suffix) in a database (Col 7 lines 6-11, 30-45).
- ii. Entering in a telephone number (second plurality of digits which represents both a prefix portion and suffix portion) (Col 4 lines 62 to Col 5 line 7).
- iii. Comparing the prefix of the dialed number to a database of stored numbers and area codes in the case where the database is limited to only exchange numbers (prefix) and associated area codes (Col 7 lines 30-47).
- iv. Dialing an area-code followed by a 7-digit telephone number once a user has dialed a 7 digit phone number whose prefix matches a previously stored number associated with an area code stored in a database (Col 10 lines 31-39).

b. **Claim 10:** In Yamartino's auto-dialer, the first plurality of digits comprises 10 digits including the area code and 7-digit telephone number. The second plurality of digits is a standard telephone number, which is comprised of a 3 digit prefix and a 4 digit suffix.

c. **Claim 11:** Yamartino discloses a method for auto-dialing a telephone number (comprising a prefix, suffix, and area code) after the caller has entered a standard 7-digit telephone number (without the area code) comprising:

- i. Storing telephone number area codes along with their associated 7-digit telephone numbers (comprising prefix and suffix) in a database (Col 7 lines 6-11, 30-45).
- ii. Entering in a telephone number (second plurality of digits which represents both a prefix portion and suffix portion) (Col 4 lines 62 to Col 5 line 7).
- iii. Comparing the prefix of the dialed number to a database of stored numbers and area codes in the case where the database is limited to only exchange numbers (prefix) and associated area codes (Col 7 lines 30-47).
- iv. If the prefix corresponds to multiple area codes, then the processor will allow the caller to select the correct area-code from a list via selector 155 (Fig. 1) (Col 5 line 64 to Col 6 line 7)
- v. Dialing a selected area-code followed by a 7-digit telephone number (second plurality of digits) (Col 10 lines 30-50).

d. **Claim 12:** In Yamartino's method, the first plurality of digits comprises 10 digits including the area code and 7-digit telephone number. The second plurality of digits is a standard telephone number, which is comprised of a 3-digit prefix and a 4-digit suffix.

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e. **Claim 13:** Yamartino's auto-dialing method includes examining a dialed 7-digit telephone number and creating a list of possible telephone numbers with associated area codes (Col 4 lines 16-25). The selection of the phone numbers and area codes on the list is based upon the prefix (exchange number) and suffix (subscriber number) entered by the caller, or just the suffix (subscriber number).

f. **Claim 14:** Yamartino's auto-dialing method examines a dialed 7-digit telephone number and creates a list of possible telephone numbers with area codes (Col 4 lines 16-20). Yamartino mentions that the list may be visually displayed to the user, and that the user may use the keypad to dial a digit in order to select the number to be dialed (Col 6 lines 31-53).

g. **Claim 15:** Yamartino's auto dialer can examine a dialed 7-digit telephone number and create a list of possible telephone numbers with area codes (Col 4 lines 16-20). Yamartino mentions that the list may be audibly presented to the user with a voice synthesizer, and that the user may use the keypad to dial a digit in order to select the number to be dialed (Col 6 lines 31-53).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. **Claims 1,2,16** rejected under 35 U.S.C. 103(a) as being unpatentable over Yamartino (09291213), and further in view of Eaton (5710808).

a. **Claim 1:** Yamartino discloses a telephone number dialer that dials a phone number plus area code after the user has entered a 7 digit telephone number (the number comprising a prefix and suffix portion) comprising:

- i. A keypad used to enter in telephone digits (Col 4 lines 62-65).
- ii. Area code processor 110 coupled to a keypad at the calling party 180 and to the phone line through caller interface 140 and call generator 160 (Fig. 1) (Col 4 lines 27-36)
- iii. Area code processor 110 is coupled to Database 120 (Fig.1). The database is used to store area codes along with their associated 7-digit telephone numbers (each 7-digit number comprising a prefix and suffix) (Col 7 lines 6-11). Non-Volatile memory is inherent to a microprocessor system that is maintaining an updatable database of information for the purpose of storing the information.
- iv. In one embodiment of Yamartino's invention, the processor will automatically dial an area-code followed by a telephone number (the first plurality of digits consisting of the area code plus the telephone number) once a user has dialed a telephone number whose prefix corresponds (is 'associated' with) to a previously stored number associated with an area code stored in a database (Col 7 lines 30-47).
- v. As per the amended portion of the claim stating 'such that entry of said second plurality of digits being representative of a prefix portion, and associated



with one of said stored area codes occurs prior to completion of entry of said second plurality of digits', in Yamartino's device, the entry of the 'prefix' portion of the second plurality of digits occurs prior to completion of entry of said second plurality of digits because by definition, the prefix is dialed before the suffix.

However, Yamartino does not disclose the dialer system checking the database for a prefix associated with an area code, and then initiating the dialing while the second plurality of digits is being dialed.

Eaton discloses a dialer system that provides enhanced dialing services to customers such as altering or blocking a portion of the received digits, or adding a string of digits to the received digits before dialing them out to the network (Col 1 lines 34-49). He discloses that his system will read in digits (from a telephone for example) and match a string of digits (such as a telephone number prefix) to a translation table (database). Once the match occurs the string of digits plus any modifications (such as adding an area code for example) is sent to the output buffer and dialed out. This occurs before the user has finished dialing digits. After the modified digit string is sent out, the device will continue to send out any digits dialed by the user (ie. the remainder of the 'second plurality of digits') (Col 7 lines 24-52, and Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of this application to implement Eaton's device (comprising a microprocessor operative to initiate dialing of the modified string while the remainder of the number is being entered by the user) for the purpose of providing

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enhanced services to the user such as adding to, altering or blocking a portion of the received digits to facilitate billing or user identification.

b. **Claim 2:** In Yamartino's auto-dialer, the first plurality of digits comprises 10 digits including the area code and 7-digit telephone number. The second plurality of digits is a standard telephone number, which is comprised of a 3-digit prefix and a 4-digit suffix.

c. **Claim 16:** Yamartino mentions that the phone dialer (which includes the microprocessor and non-volatile memory) may be implemented as part of the telephone switching system, which is located in a central office (Col 3 line 66 to Col 4 line 11).

### **Conclusion:**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.



**DUC NGUYEN  
PRIMARY EXAMINER**

AJ  
February 17, 2004